

**TERMINAL DISCLAIMER TO OBVIATE A DOUBLE PATENTING  
REJECTION OVER A PRIOR PATENT**

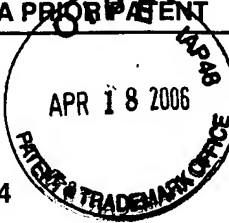
Docket No. (Optional)  
**3116.RHWU.CN2**

In re Application of: **Ruey-Jen Hwu**

Application No.: **10/768,426**

Filed: **January 29, 2004**

For: **HIGH-POWER BLUE AND GREEN LIGHT LASER GENERATION FROM HIGH-POWERED DIODE LASERS**



The owner\*, Ruey-Jen Hwu of 100 percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 and 173, as presently shortened by any terminal disclaimer, of prior Patent No. US 6,414,973. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the prior patent are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 to 156 and 173 of the prior patent, as presently shortened by any terminal disclaimer, in the event that it later: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. 1.321, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

Check either box 1 or 2 below, if appropriate.

1. ☐ For submissions on behalf of an organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the organization.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful statements may jeopardize the validity of the application or any patent issued thereon.

2. ☒ The undersigned is an attorney of record.

04-12-06  
Date

Signature

Paul C. Oestreich  
Typed or printed name

- ☒ Terminal disclaimer fee under 37 CFR 1.20(d) is included.

**WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.**

\*Statement under 37 CFR 3.73(b) is required if terminal disclaimer is signed by the assignee (owner).  
Form PTO/SB/96 may be used for making this statement. See MPEP § 324.

04/19/2006 HMARZ11 00000042 10768426

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65.00 OP

## ASSIGNMENT

Whereas, the University of Utah Research Foundation ("UURF"), having a place of business at 615 Arapeen Drive, Suite 310, Salt Lake City, Utah 84108 has a joint ownership interest in the United States Letters Patent entitled: **High-Power Blue and Green Light Laser Generation from High Powered Diode Lasers**, listed with inventors Ruey-Jen Hwu, John Worlock, Michael Willis, and Robert Gwynn, issued in the United States Patent and Trademark Office as Patent No. 6,414,973 on July 2, 2002, which Patent is incorporated herein by this reference; and the invention therein described; and

Whereas, the UURF received joint ownership rights to such patent on September 12, 2002 from the University of Utah, having acquired such rights from John Worlock and Robert Gwynn on August 31, 2002 and September 11, 2002, respectively, as evidenced by the documents attached as Exhibit A; and

Whereas, Ruey-Jen Hwu Sadwick, a citizen of the United States having an address of 3767 East Brockbank Drive, Salt Lake City, Utah 84124, is desirous of acquiring the UURF's right, title and interest in and to the said invention within the United States of America and its territorial possessions and within the countries foreign to the United States and any United States or foreign Letters Patent that may be granted therefor; and in and to said Patent;

Now, Therefore, in exchange for good and valuable consideration, the receipt of which is hereby acknowledged, the UURF has sold, assigned and transferred and by these presents does hereby sell, assign and transfer unto the said Ruey-Jen Hwu Sadwick its right, title and interest in and to the said Patent within the United States of America and its territorial possessions and within all countries foreign to the United States and in and to any United States or foreign Letters Patent that may be granted therefor and in and to the application for the said Patent and in and to any Letters Patent that may be granted thereon and in and to any and all divisions, reissues, continuations, continuations in part, and extensions of the said Patent, all said rights to be held and enjoyed by Ruey-Jen Hwu Sadwick for her own use and enjoyment and/or the use and enjoyment of her successors and assigns to the full end of the term or terms for which said Letters Patent may be granted as fully and entirely as the same would have been held and enjoyed by the UURF if this assignment, transfer and sale had not been made.

In Testimony Whereof, the UURF has caused the hand of its duly authorized and proper representative to be subscribed hereto this 13<sup>th</sup> day of July, 2004.

UNIVERSITY OF UTAH RESEARCH FOUNDATION

By: Rayne F. Gesteland  
Raymond F. Gesteland, Ph.D., President

R F Gesteland

## ASSIGNMENT

Whereas, the University of Utah Research Foundation ("UURF"), having a place of business at 615 Arapleen Drive, Suite 310, Salt Lake City, Utah 84108 has a joint ownership interest in the United States Letters Patent entitled: **High-Power Blue and Green Light Laser Generation from High Powered Diode Lasers**, listed with inventors Ruey-Jen Hwu, John Worlock, Michael Willis, and Robert Gwynn, issued in the United States Patent and Trademark Office as Patent No. 6,650,665 on November 11, 2003, which Patent is incorporated herein by this reference; and the invention therein described; and

Whereas, the UURF received joint ownership rights to such patent on September 12, 2002 from the University of Utah, having acquired such rights from John Worlock and Robert Gwynn on August 31, 2002 and September 11, 2002, respectively, as evidenced by the documents attached as Exhibit A; and

Whereas, Ruey-Jen Hwu Sadwick, a citizen of the United States having an address of 3767 East Brockbank Drive, Salt Lake City, Utah 84124, is desirous of acquiring the UURF's right, title and interest in and to the said invention within the United States of America and its territorial possessions and within the countries foreign to the United States and any United States or foreign Letters Patent that may be granted therefor; and in and to said Patent;

Now, Therefore, in exchange for good and valuable consideration, the receipt of which is hereby acknowledged, the UURF has sold, assigned and transferred and by these presents does hereby sell, assign and transfer unto the said Ruey-Jen Hwu Sadwick its right, title and interest in and to the said Patent within the United States of America and its territorial possessions and within all countries foreign to the United States and in and to any United States or foreign Letters Patent that may be granted therefor and in and to the application for the said Patent and in and to any Letters Patent that may be granted thereon and in and to any and all divisions, reissues, continuations, continuations in part, and extensions of the said Patent, all said rights to be held and enjoyed by Ruey-Jen Hwu Sadwick for her own use and enjoyment and/or the use and enjoyment of her successors and assigns to the full end of the term or terms for which said Letters Patent may be granted as fully and entirely as the same would have been held and enjoyed by the UURF if this assignment, transfer and sale had not been made.

In Testimony Whereof, the UURF has caused the hand of its duly authorized and proper representative to be subscribed hereto this 13 day of July, 2004.

UNIVERSITY OF UTAH RESEARCH FOUNDATION

By: R F Gesteland  
Raymond F. Gesteland, Ph.D., President

**ASSIGNMENT**

**EXHIBIT A**

## ASSIGNMENT

WHEREAS, I, Robert Gwynn, whose post office address is 5016 Overlook Dr., Bloomington, MN, 55437, along with others have invented a certain product and process claimed in an application for United States Patent of Hwu *et al.* entitled "HIGH-POWER BLUE AND GREEN LIGHT LASER GENERATION FROM HIGH POWERED DIODE LASERS," which was executed on August 31, 2000, bearing Serial No. 09/652,490, and filed by the firm of Christensen, O'Connor, Johnson and Kindness, bearing attorney Docket No. HWUJ-1-15904;

WHEREAS, assignee, UNIVERSITY OF UTAH, a university of higher education, and a nonprofit corporation, organized and existing under the laws of the State of Utah, located at Salt Lake City, Utah, is desirous of acquiring the entire right, title and interest in the same;

NOW, THEREFORE, in consideration of one dollar (\$1.00), the receipt and sufficiency whereof is hereby acknowledged, and other good and valuable consideration, I, the said inventor, by these presents do sell, assign, and transfer unto said institution, the full and exclusive right to the said invention and in and to said application and any and all divisions and continuations, substitutes and reissues of said application and its entire right, title and interest in, to and under any and all Letters Patent of the United States and foreign countries that may issue or be granted on said invention.

The Commissioner of Patent is hereby authorized and requested to issue said Letters Patent to said UNIVERSITY OF UTAH as the assignee of the entire right, title and interest in and to the same, for its sole use and behalf; and for the use and behalf of its legal representatives, to the full end of the term for which said Letters Patent may be granted, as fully and entirely as the same would have been held by me had this assignment and sale not been made.

EXECUTED this 11 day of September, 2002

Robert Gwynn

Robert Gwynn

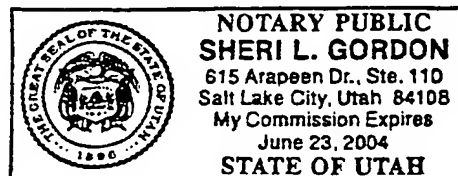
STATE OF UTAH

SALT LAKE COUNTY

Before me personally appeared, Robert Gwynn, who acknowledged his execution of the foregoing instrument to be his free act and deed this 11th day of September, 2002.

Sheri L. Gordon

Notary Public



My Commission Expires:

June 23, 2004

Residing at Salt Lake City, Utah

## ASSIGNMENT

WHEREAS, I, John M. Worlock, whose post office address is 2440 East 900 South, Salt Lake City, Utah 84108, along with others have invented a certain product and process claimed in an application for United States Patent of Hwu et al. entitled "HIGH-POWER BLUE AND GREEN LIGHT LASER GENERATION FROM HIGH POWERED DIODE LASERS," which was executed on August 31, 2000, bearing Serial No. \_\_\_\_\_ and filed by the firm of Christensen, O'Connor, Johnson and Kindness, bearing attorney Docket No. HWUJ-1-15904;

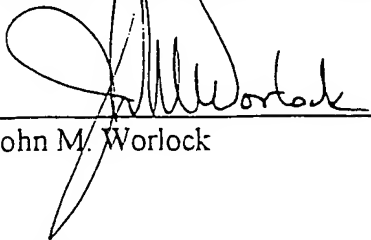
WHEREAS, assignee, UNIVERSITY OF UTAH, a university of higher education, and a nonprofit corporation, organized and existing under the laws of the State of Utah, located at Salt Lake City, Utah, is desirous of acquiring the entire right, title and interest in the same;

NOW, THEREFORE, in consideration of one dollar (\$1.00), the receipt and sufficiency whereof is hereby acknowledged, and other good and valuable consideration, I, the said inventor, by these presents do sell, assign, and transfer unto said institution, the full and exclusive right to the said invention and in and to said application and any and all divisions and continuations, substitutes and reissues of said application and its entire right, title and interest in, to and under any and all Letters Patent of the United States and foreign countries that may issue or be granted on said invention.

The Commissioner of Patent is hereby authorized and requested to issue said Letters Patent to said UNIVERSITY OF UTAH as the assignee of the entire right, title and interest in and to the same, for its sole use and behoof; and for the use and behoof of its legal representatives, to the full end of the term for which said Letters Patent may be granted, as fully and entirely as the same would

have been held by me had this assignment and sale not been made.

EXECUTED this 31<sup>st</sup> day of August, 2000 at

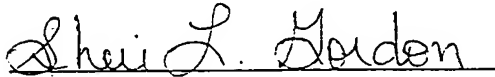
  
\_\_\_\_\_  
John M. Worlock

STATE OF UTAH )

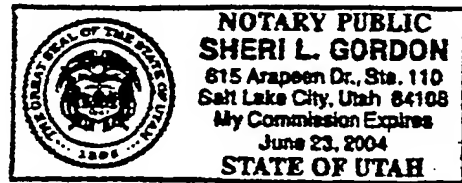
: SS

COUNTY OF SALT LAKE )

Before me personally appeared, John M. Worlock, who acknowledged his execution of the foregoing instrument to be his free act and deed this 31<sup>st</sup> day of August, 2000.

  
\_\_\_\_\_  
Sheri L. Gordon

Notary Public



My Commission Expires:

Residing at Salt Lake City, Ut



## ASSIGNMENT

Whereas, the University of Utah, a corporation of the State of Utah, having a place of business at 615 Arapleen Drive, Suite 110 Salt Lake City, Utah 84108 is the owner of the entire right, title and interest in and to application for United States Letters Patent entitled HIGH-POWER BLUE AND GREEN LIGHT LASER GENERATION FROM HIGH POWERED DIODE LASERS, filed in the United States Patent and Trademark Office as Serial No. 09/652,490 on August 31, 2000, which application is incorporated herein by this reference; and the invention therein described; and

Whereas, University of Utah Research Foundation, a corporation of the State of Utah, having a place of business at 201 S. Presidents Circle, Salt Lake City, UT 84112, is desirous of acquiring the entire right, title and interest in and to the said invention within the United States of America and its territorial possessions and within the countries foreign to the United States and any United States or foreign Letters Patent that may be granted therefore; and in and to said application;

Now, Therefore, in consideration of the sum of One Dollar (\$1.00) paid by University of Utah Research Foundation to the University of Utah and other good valuable consideration, the receipt of which is hereby acknowledged, the University of Utah has sold, assigned and transferred and by these presents does hereby sell, assign and transfer unto the said University of Utah Research Foundation the entire right, title and interest in and to the said inventions within the United States of America and its territorial possessions and within all countries foreign to the United States and in and to any United States or foreign Letters Patent that may be granted therefore and in and to the said application and in and to any and all divisions, reissues, continuations and extensions thereof and in and to any Letters Patent that may be granted thereon, all said rights to be held and enjoyed by University of Utah Research Foundation for its own use and enjoyment of its successors and assigns to the full end of the term or terms for which said Letters Patent may be granted as fully and entirely as the same would have been held and enjoyed by the University of Utah if this assignment, transfer and sale had not been made.

The University of Utah hereby authorized and requests the United States Commissioner of Patents and Trademarks and all authorized officials of foreign patent offices to issue the said Letters Patent, when granted, to said University of Utah Research Foundation as the assignee of its entire right, title and interest in and to the same, for the sole use and enjoyment of said University of Utah Research Foundation, its successors and assigns.

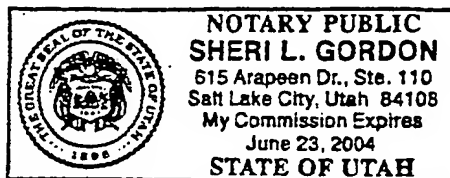
In Testimony Whereof, the University of Utah has caused the hand of its proper representative to be subscribed hereto this 12 day of September, 2002

UNIVERSITY OF UTAH

By Brent Brown  
Brent Brown  
Technology Manager, Technology Transfer

STATE OF UTAH )  
: ss.  
COUNTY OF SALT LAKE )

On September 12, 2002, before me personally appeared Brent Brown, Technology Manager, Technology Transfer of said University of Utah known to me to be the person described and who signed the foregoing Assignment in my presence and acknowledged under oath before me that she has read the same and knows the contents thereof and that the same is true of her own knowledge excepting as to matters therein alleged upon information and belief and as to those matters she believes them to be true, and that she executed the same as her free act and deed and for the purposes set forth therein.



Sheri L. Gordon  
NOTARY PUBLIC  
Residing at Salt Lake City, Utah

My Commission expires:  
June 23, 2004

# FEE TRANSMITTAL for FY 2005

Complete if Known

☒ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF  
PAYMENT

|                      |                          |
|----------------------|--------------------------|
| Application Number   | 10/768,426               |
| Filing Date          | January 29, 2004         |
| First Named Inventor | Ruey-Jen Hwu             |
| Examiner Name        | Dung (Michael) T. Nguyen |
| Art Unit             | 2828                     |
| Attorney Docket No.  | 3116.RHWU.CN2            |

## METHOD OF PAYMENT (check all that apply)

- ☒ Check    ☐ Credit Card    ☐ Money Order    ☐ None    ☐ Other (please identify): \_\_\_\_\_
- ☒ Deposit Account    Deposit Account Number: **50-0881**    Deposit Account Name: **Morriss O'Bryant Compagni, PC**
- For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)
- ☐ Charge fee(s) indicated below    ☐ Charge fee(s) indicated below, except for the filing fee
- ☒ Charge any additional fee(s) or underpayments of fee(s) under 37 CFR 1.16 and 1.17    ☒ Credit any overpayments

## FEE CALCULATION

### 1. BASIC FILING, SEARCH, AND EXAMINATION FEES

| Application Type | FILING FEES |                       | SEARCH FEES |                       | EXAMINATION FEES |                       | Fees Paid (\$) |
|------------------|-------------|-----------------------|-------------|-----------------------|------------------|-----------------------|----------------|
|                  | Fee (\$)    | Small Entity Fee (\$) | Fee (\$)    | Small Entity Fee (\$) | Fee (\$)         | Small Entity Fee (\$) |                |
| Utility          | 300         | 150                   | 500         | 250                   | 200              | 100                   |                |
| Design           | 200         | 100                   | 100         | 50                    | 130              | 65                    |                |
| Plant            | 200         | 100                   | 300         | 150                   | 160              | 80                    |                |
| Reissue          | 300         | 150                   | 500         | 250                   | 600              | 300                   |                |
| Provisional      | 200         | 100                   | 0           | 0                     | 0                | 0                     |                |

### 2. EXCESS CLAIM FEES

| Fee Description   | Fee (\$) | Small Entity Fee (\$) |
|---|----------|-----------------------|
| Each claim over 20 or, for Reissues, each claim over 20 and more than in the original patent            | 50       | 25                    |
| Each independent claim over 3, or for Reissues, each independent claim more than in the original patent | 200      | 100                   |
| Multiple Dependent claims   | 360      | 180                   |

| Total Claims | Extra Claims | Fee (\$) | Fee Paid (\$) | Multiple Dependent Claims |
|--------------|--------------|----------|---------------|---------------------------|
| -20 or HP=   | X            | =        |               | Fee (\$)                  |

HP= highest number of totals claims paid for, if greater than 20

| Indep. Claims | Extra Claims | Fee (\$) | Fee Paid (\$) |
|---------------|--------------|----------|---------------|
| -3 or HP      | X            | =        |               |

HP= highest number of independent claims paid for, if greater than 3

### 3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper, the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35. U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s)

| Total Sheets | Extra Sheets | Number of each additional 50 or fraction thereof | Fee (\$) | Fee Paid (\$) |
|--------------|--------------|--|----------|---------------|
| -100=        | /50=         | (round up to a whole number) x                   | =        |               |

### 4. OTHER FEE(S)

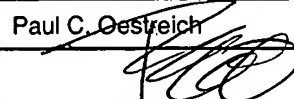
Fees Paid (\$)

Other: Terminal Disclaimer Fee (CFR 1.20(d))

65

Other:

### SUBMITTED BY

|                   |   |                  |          |           |                |
|-------------------|---|------------------|----------|-----------|----------------|
| Name (Print/Type) | Paul C. Oestreich   | Registration No. | 44,983   | Telephone | (801) 478-0071 |
| Signature         |  | Date             | 04-12-06 |           |                |